

REMARKS

The present communication responds to the Office Action dated September 17, 2008. In that Action, the Examiner rejected claims 1, 12, 23, 33, 43, 48, 57, 63, 64, and 70 under 35 U.S.C. § 101. The Examiner further rejected claims 1–75 under 35 U.S.C. § 103(a).

Claims 1, 2, 23, 33, 43, 57, 63, 64, 70, and 72–75 have been amended herewith and new claims 76–89 have been added. No new matter has been added by the amendments or new claims.

Reconsideration and allowance are respectfully requested at least for the reasons discussed below.

Rejections under 35 U.S.C. § 101

Claims 1, 12, 23, 33, 43, 48, 57, 63, 64, and 70 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Examiner based his rejections on the premise that each of the above-identified claims recite a method which is neither “tied to another statutory class” nor “transform[s] underlying subject matter to a different state or thing” In fact, claims 12, 33, 43, and 64 do not recite methods at all. Claim 12 recites “An apparatus for conveying information to a gift buyer.” Claim 33 recites “An apparatus for recording a gift item into a gift registration system.” Claim 43 recites “A card adapted for use with a gift registration system.” Claim 64 recites “A gift registry system.” Therefore, at least, claims 12, 33, 43, and 64 are not properly rejected under 35 U.S.C. § 101 as being directed to unpatentable methods. Reconsideration and withdrawal of the rejections under 35 U.S.C. § 101 are thus respectfully requested.

With respect to claims 1, 23, 48, 57, 63, and 70, Applicants have amended the preamble of claims 1, 57, 63, and 70 to more clearly show that the claimed methods are “tied to another statutory class,” i.e., the “gift registry system.” Claims 23 and 48 already explicitly state that they are tied to a “gift registry system.” As further support for the claims being directed to statutory subject matter, the claimed methods also “manipulate” or “transform” objects (and / or the relationship between the objects). *See In re Bilski*, 88 USPQ.2d 1385 (Fed. Cir. 2008) (slip

op. at 28) (“A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article [or data representing an article] into a different state or thing.”). For example, claim 1 recites “associating each gift item with an entity where the gift item may be purchased.” Claim 23 recites “recording on the machine-readable form information regarding a registrant.” Claim 48 recites “associating a list with a registrant, the list including at least one gift item.” Claim 57 recites “providing a card reader with a capability of associating additional monies with the stored value card.” Claim 63 recites “printing the list on an ATM machine.” Claim 70 recites “associating the gift list with the registrant.”

The Applicants thus respectfully submit that claims 1, 12, 23, 33, 43, 48, 57, 63, 64, and 70 recite statutory subject matter. Reconsideration and withdrawal of the rejections under 35 U.S.C. § 101 are thus respectfully requested.

Rejections under 35 U.S.C. § 103(a)

Claims 1–75 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,970,474 (LeRoy et al.). This rejection is traversed at least for the reasons discussed below.

Claim 1 recites, among other things, “A method of conveying gift registration information to a gift buyer . . . comprising . . . indicating a plurality of entities where the gift items may be purchased and associating each gift item with an entity where the gift item may be purchased.”

LeRoy does not disclose, in any manner or form, such a method. LeRoy discloses a product information system for selecting, monitoring and purchasing of products in a retail establishment. The “gift registry kiosks” and other registry apparatuses disclosed in LeRoy (which may be incorporated into a multi-store “network” of inter-communicating apparatuses) are only configured to provide gift buyers with two types of information: which gifts are on a registrant’s registry list, and which of those gifts have previously been purchased by other gift buyers. Specifically, as disclosed in the specification: “The monitor 34 or printer 36 displays the results of the search query to provide an updated list of items selected by the registrant and not

yet purchased by other customers.” LeRoy, *col. 5, ll. 31–34*. It does not provide any information concerning which retail stores in a “network” sell which gift items. Thus, it does not disclose “indicating a plurality of entities where the gift items may be purchased and associating each gift item with an entity where the gift item may be purchased.”

At least for the reasons discussed above, the Applicants respectfully submit that claim 1 is not obvious in view of LeRoy. Furthermore, because claims 2–11 depend from claim 1, the Applicants respectfully submit that claims 2–11 are not obvious in view of LeRoy.

With respect to claims 12–75, the Examiner has argued, in support of the rejections, that those claims “repeat the same limitations as claim 1, [and] are therefore rejected for the same reasons given above and incorporated herein.” To the extent that the Examiner feels that any of claims 12–75 repeat the same limitations as claim 1, such claims would not be obvious in view of LeRoy for the reasons outlined above with respect to claim 1. Thus, Applicants submit that claims 12–75 are in condition for allowance on that basis alone.

However, the Applicants respectfully disagree that any of the independent claims 12, 23, 33, 43, 48, 57, 63, 64, or 70 (and therefore any of the dependent claims which depend therefrom, which comprise the balance of claims 13–75 not previously mentioned) may be properly summarized as merely repeating the same limitations as claim 1. Independent claims 12, 23, 33, 43, 48, 57, 63, 64, and 70 claim various other aspects of the invention disclosed in the specification, as clearly set forth in the text of the claims, and would not be interpreted by those skilled in the art as duplicative of or further dependent from claim 1 (i.e., repeating the same limitations). For example, among these various other aspects, independent claims 43, 48, and 57 (and the dependent claims that depend therefrom) claim a “card”, adapted for use with certain embodiments of Applicants’ invention. Nothing the Examiner has cited to, including LeRoy, disclose a “card” as claimed in the present invention. Thus, a *prima facie* showing of obviousness has not been established, and rejection under § 103(a) is improper.

Applicants therefore respectfully request reconsideration and allowance of the pending claims.

Conclusion

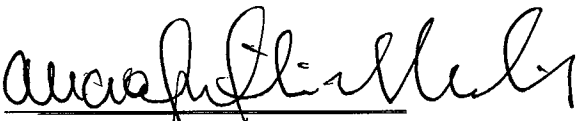
In light of these remarks, the present application is in condition for allowance, and reconsideration and allowance are requested.

This response is being submitted on or before March 17, 2009, with the required fee for a three-month extension of time, making this a timely response. It is believe that no additional fees are due in connection with this filing. However, the Commissioner is authorized to charge any additional fees, including extension fees or other relief which may be required, or credit any overpayment and notify us of same, to Deposit Account No. 04-1420.

Respectfully submitted,

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